

GAU 1614

PATENT APPLICATION NOV 02 2001

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q54487

Eiko MASATSUJI, et al.

Appln. No. 09/492,763

Group Art Unit: 1614

Confirmation No.: Unknown

Examiner: V. Kim

Filed: January 27, 2000

For: DERMAL AGENT

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

Commissioner for Patents
Washington, D.C. 20231

Sir:

A final Office Action issued July 31, 2001, in the above-identified application.

Applicants respectfully request the Examiner to withdraw the finality of the Office Action for the reason that Applicants' Response under 37 C.F.R. § 1.111 filed July 2, 2001, did not necessitate the new grounds of rejection.

Applicants' Response to the Office Action dated March 1, 2001, included a Declaration under 37 CFR 1.132 and an Information Disclosure Statement and no amendments were made to the claims. The Declaration under 37 C.F.R. § 1.132 was submitted to establish that the subject matter in the Suzuki et al upon which the Examiner relied was attributable to the present applicants. Neither reference provided with the Information Disclosure Statement filed on July 2, 2001, was relied on by the Examiner in the rejections made in the outstanding final Office Action.

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The Examiner contends that the Declaration under 37 C.F.R. § 1.132 necessitated the new grounds for rejection presented in the outstanding Office Action thereby justifying the Examiner's action in making the Office Action final.

In the Office Action, the Examiner referred to MPEP § 706.07(a) which states that a second or any subsequent action on the merits shall be final, **except** where the Examiner introduces a new ground for rejection that is: (1) not necessitated by an applicant's amendment of the claims or (2) based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c). In this case Applicants have not made any amendments to the claims nor is the Examiner's rejection based upon any information submitted in the Information Disclosure Statements filed within the period set forth above. Contrary to the Examiner's assertion, the Declaration is not an amendment to the claims and cannot serve as the basis for new grounds of rejection. Therefore the Examiner's imposition of a final rejection where new rejections are made in the absence of amendments to the claims by Applicants is improper.

Further, Applicants respectfully submit that the imposition of a final rejection under these circumstances is unfair to Applicants and against public policy. Applicants should be given a fair opportunity to define his or her invention in claims that will give patent protection to which the applicant is entitled and not be prematurely cut off in the prosecution of the application. MPEP § 706.07. To meet the goal of reaching a clearly defined issue for an early termination of proceedings, i.e., an allowance or final rejection, the Examiner is charged with conducting a careful and thorough search and fully applying the references in preparing the first Office Action on the merits in order for a speedy and just determination of the issues involved in the

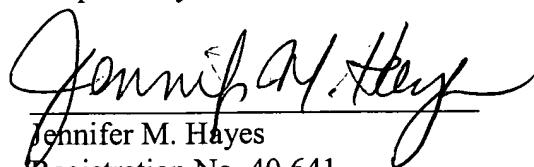
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examination of the application. See MPEP §§ 706.07 and 904.03. This includes anticipating that a reference with a publication date less than one year from the filing date of the application may be overcome by declaration or affidavit. See MPEP § 904.03.

Even further, while it is noted that two of the references cited in the instant Office Action were listed on the PTO 892 Form provided with the Office Action dated March 1, 2001, the Examiner did not rely on the references as a basis for rejecting the instant application and made no statements regarding the relevance of the references to Applicants' claimed invention. The Examiner is not required to cite all references but should compare references and cite the best reference. Where the best reference is subject to being overcome by an Affidavit or Declaration, the Examiner should additionally reject the claims based upon a second available reference. See MPEP § 904.03. Applicants should not be penalized by a premature final rejection in the event the Examiner does not comply with these procedures.

Accordingly, Applicants respectfully request withdrawal of the finality of the Office Action dated July 31, 2001.

Respectfully submitted,



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Date: October 30, 2001